

REMARKS

Favorable reconsideration of this application, in light of the following discussion, is respectfully requested. Claims 1, 2, 6-10, 13-21, 24-29, 32-36, 38, 41-45, 47, 49, and 52-61 are currently pending. Claims 1, 2, 6, 9, 10, 13, 19, 20, 21, 28, 29, 36, 38, 41, 42, and 49 have been amended herewith. Claims 58-61 have been newly added. Claims 3-5, 11, 12, 22, 23, 30, 31, 37, 39, 40, 46, 48, 50, and 51 have been cancelled without prejudice. No new matter has been added.

In the outstanding Office Action, Claims 1-5, 20-24, 46-47, and 36 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,615,052 to Parmenter et al. (hereinafter “the ‘052 patent”); Claims 5-7 and 23-26 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the ‘052 patent in view of U.S. Patent No. 6,587,672 to Chauh et al. (hereinafter “the ‘672 patent”); Claims 9-14, 17-18, 37-45, 28-33, and 48-56 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the ‘052 patent in view of U.S. Patent No. 6,374,118 to Toskala et al. (hereinafter “the ‘118 patent”); Claim 15 was rejected under 35 U.S.C. § 103(a) as being unpatentable over the ‘052 patent in view of the ‘118 patent, further in view of the ‘672 patent; Claim 57 was rejected under 35 U.S.C. § 103(a) as being unpatentable over the ‘052 patent in view of the ‘118 patent, further in view of the ‘088 patent); Claim 19 was rejected under 35 U.S.C. § 103(a) as being unpatentable over the ‘118 patent in view of the ‘052 patent.

Claim 1 was directed to a transmission power control apparatus for a wireless communication apparatus for reducing a power value of a signal input to a power amplifier to a maximum allowable input power value of said power amplifier or below. Claim 1 is amended such that the circuit type includes a packet switching type and a circuit switching type. Claim 1 was also amended such that the transmission power upper limit value

comprises a first transmission power upper limit value and a second transmission power upper limit value. The first transmission power upper limit value is associated with the packet switching type call, and the second transmission power upper limit value is associated with the circuit switching type call. Claim 1 was further amended such that the first transmission power upper limit value is set lower than the second transmission power upper limit value. Support for the amended Claim 1 is provided at least on page 30 of the Applicants' specification. No new matter has been added. By setting the transmission power upper limit value of the packet switching type call being lower than the circuit switching type, the probability of occurrence of a state in which the transmission power is reduced below the maximum allowable input value of the amplifier is decreased. Also, as a result, degradation of communication quality for the circuit switching type call can be prevented. Support for these assertions is provided in page 30 of the Application's specification.

In the rejection of Claim 1, Applicants traverse the assertion that packet switching type exclusively corresponds to data communications and circuit switching type exclusively corresponds to voice communications. Applicants are unsure if the rejection is based on Official Notice or on an assertion of inherency.

If the rejection is based on Official Notice, Applicants acknowledge that the Examiner may take official notice of facts outside of the record which are capable of instant and unquestionable demonstration as being "well-known" in the art.¹ However, as set forth in M.P.E.P. § 2144.03, if an applicant traverses an assertion made by an Examiner while taking official notice, the Examiner should cite a reference in support of their assertion. Applicants respectfully traverse those grounds for rejection relying on Official Notice. For the reasons stated below, Applicants do not consider the features for which Official Notice were taken to be "of such notorious character that official notice can be taken."

¹ *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970)

If the rejection is based on an assertion of inherency, Applicants respectfully submit that the assertion of inherency is insufficient to show that the '052 patent inherently teaches Applicants' claimed circuit/packet based power levels because the rejection fails to show "that the alleged inherent characteristic necessarily flows from the teachings of the applied prior art"² First, the Official Action provides no rationale for this finding of inherency. "The fact that a certain result may occur or be present in the prior art is not sufficient to establish inherency of that result or characteristic."³ "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'"⁴ Because the Official Action provides no explanation of why Applicants' claimed features are inherent, Applicants submit the rejection is improper.⁵ Furthermore, Applicants assert that it is well-known that some services such as packetized voice, as in ATM and Frame Relay corresponds to packet switching and some data services such as internet data traffic over a PSTN network corresponds to circuit switching.

Beyond traversing any rejection based on Official Notice or inherency, Applicants further traverse any suggestion that the '052 reference explicitly or impliedly discloses the first transmission power upper limit value of the packet switching type call and the second

²See MPEP 2112 (emphasis in original) (citation omitted). See also same section stating that "[t]he fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic," (emphasis in original). See also *In re Robertson*, 49 USPQ2d 1949, 1951 (Fed. Cir. 1999) ("[t]o establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill,'" citing *Continental Can Co. v. Monsanto Co.*, 948 F2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991); and "[i]nherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient," *Id.* at 1269 (citation omitted)).

³ *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1995, 1957 (Fed. Cir. 1993).

⁴ *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999).

⁵ MPEP § 2112, IV "Examiner must provide rationale or evidence tending to show inherency."

transmission power upper limit value of the circuit switching type call is set such that the first transmission power upper limit value is lower than the second transmission power upper limit value. Hence, Claim 1 is not anticipated under 35 U.S.C. § 102(e) by the ‘052 reference.

Applicants amend Claim 9 to include: (a) SIR determining part for determining a control target SIR value of a call according to a circuit type of said call, wherein the circuit type includes packet switching type and a circuit switching type, said control target SIR value comprising a first control target SIR value and a second control target SIR value, (b) a target SIR setting part for setting a first control target SIR value for a packet switching type call and a second control target SIR value for a circuit switching type call wherein the first control target SIR value is lower than the second control target SIR value.

In the Office Action, the Examiner asserts that the ‘118 patent teaches a SIR determining part that sets a first control target SIR for a call of a packet switching type and a second control target SIR for a circuit switching type, and that the first control target SIR value “-3.5 dB” is lower than the second control target SIR value “-4.2 dB”. Applicants respectfully assert that this assertion is not correct because clearly -3.5 dB is greater than -4.2 dB. Moreover, the Examiner does not provide any motivation for combining the ‘052 patent with the ‘118 patent. Accordingly, Applicants respectfully submit that a *prima facie* case of obviousness has not been established and the rejection of Claim 9 should be withdrawn.

Independent Claims 20, 36, 46, and 47 recite limitations analogous to the limitations recited in Claim 1. Accordingly, for the reasons stated above for the patentability of Claim 1, Applicants respectfully traverse the rejection of Claims 20, 36, 46 and 47 (and all similarly rejected dependent claims) as anticipated by the ‘052 patent.

Independent Claims 19 and 28 recite limitations analogous to their limitations recited in Claim 9. Accordingly, for the reasons stated above for the patentability of Claim 9,

Applicants respectfully traverse the rejection of Claims 19 and 28 (and all similarly rejected dependent claims as anticipated by the combination of the '052 and the '118 patent).

The present amendment also sets forth new Claims 58-61 for examination on the merits. New Claims 58-61 are supported by the Applicants' specification at least on page 29. No new matter has been added. Moreover, based on the asserted patentability of Claims 1, 20 and 28, Applicants respectively submit that the new Claims 58-61 patentably define over any proper combination of the cited references.

Consequently, in view of the present amendment and in light of the above-discussion, the outstanding grounds for rejection are believed to have been overcome. The application as amended herewith is believed to be in condition for formal allowance. An early and favorable action to that effect is respectfully requested.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



Customer Number
22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 06/04)

Bradley D. Lytle
Attorney of Record
Registration No. 40,073
Michael E. Monaco
Registration No. 52,041